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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/247,795

02/08/1999

PASCAL OUDET

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01/22/2003

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EXAMINER

CHUNG TRANS, XUONG MY

ART UNIT

PAPER NUMBER

2181

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/247,795

Applicant(s)

OUDET, PASCAL

Examiner

Xuong M. Chung-Trans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. This is response to the communication filed on 12/20/02.

Claims 1-8 and 10-19 are pending in this application.

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the address detecting means and address remapping means must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blackledge et al. (U.S. Pat. No. 5,835,738) in view of Garbus et al. (U.S. Pat. No. 5,884,027).

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As per claims 1, 3, 4, 10, 13 and 15-17, Blackledge et al disclose an expansion bus means (50) for connecting first section bus and a second section bus (56,58) wherein each section comprising at least one station devices. The expansion bus means (50) comprises an address detecting means (52) for detecting an address received from one section bus and an address mapping and translating means (54) for mapping the received input address and changing the input address and output address from one type to another (see col. 5, line 66- col. 6, line 8; col. 6, lines 17- 45; col. 11, lines 27-32). Blackledge does not explicitly disclose a bi-direction address translation. Garbus discloses such a bi-directional address translation (fig. 3, elements 43a, 43b; fig. 4; col. 6, lines 5-50; col. 22, line 37-58). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include the teaching of Garbus in the Blackledge system in order to provide a bi-direction address translation. This is because both deal with the same address translation art.

As per claims 2, 12, 14 and 19, Blackledge does not explicitly teach that the format of a physical address comprises a fixed part and a setable part, and wherein the dummy address is obtained by changing at least one bit of the fixed part of the physical address. Blackledge, however, teaches that the addresses can be change from one type to the other (col. 5, line 66 to col. 6, line 9, col. 8, lines 3-5 and col. 12, lines 5-28). It would have ben obvious to one of ordinary skill in the art, at the time the invention was made, to employ the address translation of Blackledge to change at least one bit of an address and preferably one bit of a fixed part of an

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address as claimed. This is because the manner in which the address translation changes at least one bit of an address would be a matter of choice and design.

As per claims 5-8 and 11, Blackledge does not explicitly disclose that the bus is a two wire serial bus having one data wire and one clock wire. However, the use of two wire serial bus is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to substitute one well known bus with another well known bus so long they performed the same and/or equivalent function(s) because the bus is used as an interconnect/communication bus/mechanism between devices/components and processor/memory system.

As per claim 18, claim 18 differs from claims 1,4,10, 13 and 16 in that it recites the address remapper is transparent. Both Blackledge and Garbus disclose an address translation is transparent (e.g. without user intervention). See Garbus, col. 6, lines 39-57.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 10, 13, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Fox et. al. (U.S. Pat. No. 5,636,216).

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As per above claims Fox discloses (figs.1-2) network bus means (10, 16, 14, 22) for connecting first section bus and a second section bus wherein each section comprising at least one station devices. The network bus means comprises an address detecting means (10, 14) for detecting an address received from one section bus and an address mapping and translating means (10, 14, 22) for mapping the received IP address and changing the IP address to a network specific local address.

8. Applicant's arguments filed on 12/20/02 have been fully considered but they are not persuasive.

Regarding claim 18, Applicant argues that the address translation of Blackledge is not transparent. The Examiner respectfully disagreed. This is because the address translation of Blackledge recognizes the address range and can translate the address range from one type to another.

Regarding to motivation to combine, applicant argues that there is no motivation or suggestion in the applied prior art. The examiner disagrees. The test of obviousness is:

“whether the teaching of the prior art, taken as a whole, would have made obvious the claimed invention,” In re Gorman, 933 F.2d at 986, 18 USPQ 2d at 1888.

Subject matter ⁵is unpatentable under section 103 if it “‘would have been obvious ... to a person having ordinary skill in the art.’ While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that

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the cited references or prior art specifically suggest making the combination.” In re Nilssen, 851 f.2d 1401, 1403, 7 USPQ 2d 1500, 1502 (Fed. Cir. 1988).

Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem with it addresses.” In re Wood, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

“In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teaching is found in the a specific reference.”

Entire quote from In re Oetiker, 24 USPQ 2d 1443 (CAFC 1992).

According, it is not required to disclose or specifically suggest particular elements. Instead the measure is what the teaching would suggest to one of ordinary skill in the art, not what the art specifically suggests.

Further, applicant argued that the examiner has used hindsight in combining the references used in the art rejections. The examiner respectfully disagrees. Hindsight has not been resorted to other than is justified by the combination of prior art references considered as a whole. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xuong M. Chung-Trans whose telephone number is (703) 305-9772. The examiner can normally be reached on Monday-Friday from 9:30AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



X. M. Chung-Trans



SUMATI LEFKOWITZ
PRIMARY EXAMINER